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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,412	07/30/2001	Bin Lu	ENR-015	4205

7590

08/26/2005

WAGNER, MURABITO & HAO LLP  
THIRD FLOOR  
TWO NORTH MARKET STREET  
SAN JOSE, CA 95113

EXAMINER
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PRIETO, BEATRIZ

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/919,412

Applicant(s)

LU ET AL.

Examiner

Prieto B.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***DETAILED ACTION***

1. This communication is in response to Amendment filed 06/09/05, claims 1-43 were examined.

***Claim Rejection under 35 U.S.C. 103***

2. Quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action may be found in previous office action.

3. Claims 1-6, 8-9, 13-21, 23-24, 28-36, 38, 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuzma (US 5,771,355) in view of Hoffert et. al. (US 5,903,892) (Hoffert hereafter).

Regarding claim 1, Kuzma teaches a system (Figs. 1-3 and col 1/lines 26-56) and method (col 14/lines 24-43) configured to communicate media files, comprising:

a sender client configured to provide a message comprising: a recipient address and a handle to a media file (col 1/lines 13-22, col 2/lines 24-58), the handle to the media comprising reference to the media file (col 1/lines 36-67), and a pointer location to the media file (col 5/lines 10-54);

a server configured to receive and provide said message from the sender client to a receiver client that corresponds with said recipient address, said receiver client configured to receive said message from said server (col 3/lines 26-62);

wherein said receiver client is configured to access said media file from the sender client and a peer receiver client source of the media file (col 44/lines 44-47, col 5/lines 10-54 and col 6/lines 8-15), however Kuzma teaches a message comprising a handle to a media file, he does not teach where the media file includes copyright information.

Hoffert teachings related to the field of digital media such as audio/video clips (abstract, background) including the delivery via an email server (col 28/lines 11-16), teaches wherein to facilitate the delivery/retrieval of media files by indexing streaming media files with information describing the media files content, including a handle to the media file, e.g. URL and content attributes such as title, author, copyright information (col 6/lines 53-col 7/line 19).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given the suggestion of Kuzma for retrieving media files using a handle to the media file, the teachings of

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Hoffert for enabling the retrieval of media files by attributes other than their type, as suggested by Hoffert. One would be motivated to enhance files transmittable over the Internet including email, with file indexing attributes more descriptive of the content, such as the media file location, e.g. socket, header data, title, author, copyright, additional information such as resolution, duration, resolution, frame rate, etc. this would enable the receiver client ascertain the resources and the time required for selectively downloading desired media file.

Regarding claims 2-3, wherein the sender and receiver clients are a personal computer (120 of Figs. 1-2, col 3/lines 7-18).

Regarding claim 4, wherein the server is an application service provider accessed via an Internet (301)(col 3/lines 19-46, col 3/line 63-col 4/line 10).

Regarding claim 5, wherein said message comprises a text of data information (col 1/lines 23-25).

Regarding claim 6, address are network email address (col 1/lines 14-22)

4. Claims 7, 22, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuzma in view of Hoffert in further view of Hsu et. al. (US 6,295,058) (Hsu hereafter).

Regarding claim 7,

Hsu teachings pertaining the invention's field of endeavor, discusses as prior art the transmission of electronic mail containing audio and/or visual files obtained from various sources, e.g. a video cassette recorder or camcorder are converted in a suitable format, e.g. MPEG and stored locally on a storage device, and transmitting stored files as an email to a mail server (col 2/lines 3-15).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given the suggestion of Kuzma that the personal computers may be any suitable computer system which additionally may include a special purpose video processor, a video camera, and graphic viewer programs for rendering graphic files associated with email messages. One ordinary skilled in the art would be motivate create multimedia emails with a simple for of electronic communication to enable accessible to the general public and using an open architecture providing a service independent of the email service provider, as taught by Hsu.

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Regarding claims 8-9, the sender and receiver client is further configured to use an HTTP protocol to provide and receive the location message (Kuzma: col 3/lines 63-col 4/line 31, 44-50).

5. Claims 10-12, 25-27 and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuzma in view of Hoffert in further view of Thurlow et. al. (US 6,457,879) (Thurlow hereafter).

Regarding claims 10-12, 25-27 and 39-41, however Kuzma does not explicitly teach a connection determination step.

Thurlow teaching pertaining to the invention's field of endeavor, teach determining the connection status between a client and server (col 15/lines 47-57, col 16/lines 54-67), and processing messages according to determined connection status (abstract).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given the suggestion of Kuzma for enabling clients to have server functions to enable any client access each other in a peer fashion to include Thurlow's teachings for processing messages, e.g. sending and receiving between clients via servers. The teachings of Thurlow when applied to Kuzma will enable the clients or server to perform connection status determinations and process messages according to determined status. One would be motivated to provide users poll email server or client, e.g. recipients while online for incoming messages or reception availability, respectively, or offer user the option to work online or offline, discussed by Thurlow.

Regarding claims 13-15, connections between sender, mail server and recipient are Internet protocol based supported (Kuzma: col 12/lines 33-49). The system of claim 1, further comprising:

Regarding claim 16, this claim is substantially the same a claim 1 as discussed, wherein "configured" has been changed for "coupled", same rationale of rejection is applicable.

Regarding claims 17-22, these claims are substantially the same as claims 2-7, discussed above same rationale of rejection is applicable.

Regarding claim 23, the protocol used by the receiver client to provide the location message is HTTP (Kuzma: col 12/lines 33-49).

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Regarding claim 24-30, these claims are substantially the same as claims 9-15, same rationale of rejection is applicable.

Regarding claim 31, this claim comprises in substance the same subject matter discussed on claim 1, same rationale of rejection is applicable.

Regarding claims 32-43, these claims are substantially the same as claims 2-15, same rationale of rejection is applicable.

**Pertinent Prior Art:**

6. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure; pertinence is presented in accordance with MPEP§ 707.05. Copies of Non-Patent Literature documents cited are provided as set forth in MPEP§ 707.05(a):

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Taylor et. al. On Fig. 5 an exemplary partial play list for playing media clips, play list 505 includes one or more references to media clips, such as reference 510, which may include **handle**, i.e. media clip location information and clip information. Clip information 520 may include such things as the **title** and author of the media, **copyright** information, a **link** to a WWW page containing more information about the media, and other information related to the media clip.

US 5,956,716

Kenner et. al. teaches a system and method for delivery of video data over a computer network. The source IM 90 registers the clip in its own clip database, storing information including the **name**, date, time, video ID, rating, **copyright** information, subscription information, content information, and other attributes of the clip as the clip is transferred from the content provider.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Andrew T. Caldwell can be reached at (571) 272-3868. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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P.O. Box 1450  
Alexandria, VA 22313-1450

Hand carried or delivered to:

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401 Dulany St.  
Alexandria, VA 22314

Faxed to the Central Fax Office:

(703) 872-9306 (old No. in service until Sept. 15, 2005),  
(571) 273-8300 (New Central Fax No.)  
Or Telephone: (703) 306-5631 for TC 2100 Customer Service Office.

  
BEATRIZ PRIETO  
PRIMARY EXAMINER